The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ALEXANDER C. TAIN

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Appeal No. 2001-0326
Application 09/007,138

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ON BRIEF

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Before FLEMING, LALL, and SAADAT, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

Appellant's invention generally relates to a computer implemented method for converting an input representation (30, 34) of a pattern of integrated circuit interconnects (32) in a format suitable for a circuit design program into an output representation (46) in a format suitable for a package design program. See Appellant's specification, Figures 4 and 10, see also page 3, lines 19-24; page 5 lines: 8-15, lines: 20-30.

1

This is accomplished by controlling the computer to run a converter program which converts the input representation (30, 34) into an intermediate representation in a format suitable for a mechanical design program (42, 44). See Appellant's specification Figures 6 and 8, see also page 3, lines 26-34. Then further controlling the computer to run a mechanical design program (58) which is adapted to automatically input the intermediate representation (42, 44), identify and label the interconnects, and create the output representation (48) in which the interconnects are labeled (See Appellant's specification Figure 10, see also page 3, line 36 through page 4 line 6; page 6, lines: 15-25).

References

The references relied on by the Examiner are as follows:

Jimbo et al.	5,517,421	May 14, 1996
Fulcher	5,686,764	Nov. 11, 1997
Stager et al.	5,777,383	July 7, 1998
		(filed May 9, 1996)

Rejections at Issue

Claims 1, 2, 4, 5, 8-16, 19-24, 26, and 29-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jimbo et al. (hereinafter referred to as "Jimbo").

Claims 3, 14, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jimbo in view of Stager et al.

Claims 6, 7, 17, 18 and 27-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jimbo in view of Fulcher.

Opinion

With full consideration begin given to the subject matter on appeal, the Examiner's rejections and arguments of the Appellant and Examiner, we cannot sustain the rejections of claims 1, 12 and 23 which were rejected under 35 U.S.C. § 103.

On page 8, lines 8-12 of the Appeal Brief, Appellant argues that his invention "begins where Jimbo leaves off". Appellant argues that his invention "inputs data generated by a CAD program (e.g. output data from a program for which Jimbo's format conversion produces input data) and converts it into an output representation suitable for a package design program". Appellant points out that the Examiner admitted that Jimbo does not teach the claimed limitation of converting a circuit design format to a package design format. See Appeal Brief, Paper No. 9, dated March 20, 2000, page 8, lines 29-31). Appellant further argues that the Examiner has not provided any evidence which supports a showing that prior art teaches or suggests enabling "a conversion from a format necessary for a circuit design program to format

necessary for a package design program as required in the explicit language of claim 1." See Appeal Brief, Paper No. 9, page 9, lines 28-32.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed Cir. 1992). **See also** *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 87 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ at 1444. **See also** *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

"[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, **see** *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d

1626, 1630 (Fed. Cir.1996), *Para-Ordnance Mfg. v. SGS Importers Intern., Inc.,* 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet,* 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. *See, e.g., C.R. Bard,* 157 F.3d at 1352, 48 USPQ2d at 1232.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all the evidence and arguments." *In re Oetiker,* 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee,* 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellant and Examiner. Independent claims 1 includes the following limitations:

> [C]onverting an input representation of a pattern of integrated circuit interconnects in a format suitable for a

circuit design program into an output representation in a
format suitable for a package design program, comprising the
steps of:

a converter program which converts the input representation
into an intermediate representation in a format suitable for
a mechanical design program; and

a mechanical design program which is adapted to
automatically input the intermediate representation,
identify and label the interconnects, and create the output
representation in which the interconnects are labeled.

We note that claims 12 and 23, the only other independent claims,

recite similar limitations, as do the rest of the appealed

claims, being the dependent claims.

On page 4, first column, third paragraph of the Examiner's

Answer, the Examiner admits that Jimbo fails to teach "conversion

of a **circuit design** format to a **package design** output format".

The Examiner provides an unsupported rationale that it would be

obvious to "convert data into formats suitable for use by

particular CAD tools for easy design data management, this

capability would extend to include the conversion from a format

necessary for circuit design application programs (one CAD tool)

to a format necessary for a package design program (another CAD

tool)". The Examiner asserts that a package design program is a

CAD tool. Further on page 4, second column, fifth paragraph of

the Examiner's Answer, the Examiner admits that Jimbo fails to

teach "conversion an from input representation to (Jimbo's one

representation) an intermediate representation". The Examiner

again provides an unsupported rationale that it would be obvious

that a "representation converting means converts one

representation to another representation, this would include

conversion from an input representation (Jimbo's one

representation) to an intermediate representation (another

representation)".

Upon review, we find that there is no evidence of record to

support converting an input representation of a pattern of

integrated circuit interconnects in a format suitable for a

circuit design program into an output representation in a format

suitable for a package design program, as required by claims 1,

12 and 23. The Examiner's conclusory statements and unsupported

rationales do not constitute evidence. Broad conclusory

statements regarding the teaching of multiple references,

standing alone, are not "evidence." *E.g., McElmurry v. Arkansas*

Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131

(Fed. Cir.1993) "Mere denials and conclusory statements, however,

are not sufficient to establish a genuine issue of material

fact." *See In re Dembiczak,* 175 F.3d 994, 1000, 150 USPQ2d 1614, (Fed. Cir. 1999), *In re Sichert,* 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). Without such evidence, we cannot find that Jimbo anticipates Appellant's conversion of an input representation suitable for a circuit design program to an output representation suitable for a package design program. Consequently, the Examiner's § 103 rejection based on Jimbo of claims 1, 12, and 23 is reversed.

REVERSED.

MICHAEL R. FLEMING Administrative Patent Judge	)	
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	)	BOARD OF PATENT
PARSHOTAM S. LALL Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
MAHSHID SAADAT Administrative Patent Judge	)	

MRF:pgg

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